THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARKEV KEOSHKERIAN, MICHAEL K. GEORGES, PETER M. KAZMAIER and GORDON K. HAMER

Appeal No. 98-3269
Application No. 08/703,266[1]

ON BRIEF

Before KIMLIN, JOHN D. SMITH and PAK, Administrative Patent Judges.

KIMLIN, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the final rejection of claims 1-14 and 16-20, all the claims remaining in the present application. Claim 1 is illustrative:

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[1] Application for patent filed August 26, 1996.

1. A process for the preparation of resin particles comprising:

heating a mixture comprised of a free radical initiator compound, at least one stable free radical compound, at least one free radical polymerizable monomer compound, and at least one free radical polymerizable crosslinking compound;

and cooling the mixture, wherein the resulting product resin particles are crosslinked and are comprised of polymerized monomers and at least one crosslinking compound, and wherein the particles have a narrow particle size distribution of from about 1.1 to about 2 geometric size distribution (GSD), a narrow pore size distribution of from about 10 to about 1,000 nanometers, and a high monomer to polymer conversion of from about 10 to about 100 percent.

The examiner relies upon the following references as evidence of obviousness:

Wada et al. (Wada)	5,104,764	Apr. 14, 1992
Georges et al. (Georges)	5,322,912	Jun. 21, 1994

Appellants' claimed invention is directed to a process for preparing resin particles having a specific particle size distribution. The process comprises heating a mixture comprising a free radical initiator compound, a stable free radical compound, a free radical polymerizable monomer and a free radical polymerizable crosslinking compound, such as divinyl benzene.

Appealed claims 1-14 and 16-20 stand rejected under 35 U.S.C. § 112, first paragraph, as being based upon a non-

enabling disclosure. In addition, the appealed claims stand rejected under 35 U.S.C. § 103 as being unpatentable over Georges in view of Wada.

Upon careful consideration of the opposing arguments presented on appeal, we will not sustain the examiner's rejections.

We consider first the rejection of the appealed claims under 35 U.S.C. § 112, first paragraph. In essence, it is the examiner's position that appellants' specification does not provide enabling support for the breadth of the subject matter claimed. In the words of the examiner, the specification "does not reasonably provide enablement for the myriad [of] monomer combinations and process conditions within the broad language of the claims" (page 9 of Answer). The examiner refers to the fact that "the working examples set forth only three monomers and one crosslinking monomer to support claims which read on thousands of monomers, crosslinking monomers and unlimited combinations thereof" (page 10 of Answer).

It is well settled that the examiner bears the initial burden of establishing lack of enablement by compelling reasoning or objective evidence. In re Strahilevitz, 668 F.2d

1229, 1232, 212 USPQ 561, 563 (CCPA 1982); In re Marzocchi, 439 F.2d 220, 223, 169 USPQ 367, 369 (CCPA 1971). In the present case, we concur with appellants that the examiner's assertion of non-enablement is conclusory by virtue of not specifically pointing to non-enabling aspects of the disclosed and claimed invention. For example, whereas the examiner points out that the specification examples employ only one crosslinking agent, the specification discloses a variety of free radical polymerizable crosslinking compounds in the paragraph bridging pages 17 and 18. In our view, the examiner has merely offered speculation that one of ordinary skill in the art would have to resort to undue experimentation in order to practice processes within the scope of the appealed claims. In the absence of factual, evidentiary support, the examiner's rejection cannot stand.

We now turn to the examiner's rejection of the appealed claims under 35 U.S.C. § 103 over the combined teachings of Georges and Wada. Georges discloses a free radical polymerization process for preparing resins having a narrow molecular weight distribution that does not employ the claimed crosslinking compound in the reaction mixture. Wada, on the

other hand, discloses a process for preparing polymer particles that does not contain the claimed stable free radical compound in the reaction mixture. Significantly, we find no teaching or suggestion in Georges to use the crosslinking compound employed by Wada, nor do we find any teaching or suggestion in Wada for utilizing the stable free radical compound disclosed by Georges. In the absence of such a requisite teaching or suggestion, we must conclude that the examiner's rejection is based upon the use of impermissible hindsight to arrive at the claimed invention.

In addition, the examiner recognizes that neither of the applied references discloses obtaining polymer particles having the claimed particle size distribution. In the absence of such teaching, the examiner reasons that "in view of the similarity of the present method to those of both references, there is a reasonable basis to believe that the claimed particle size distribution and pore size distribution are the inherent result of the reference processes and the burden is on appellant to show otherwise. *In re Spada*, [911 F.2d 705, 708,] 15 USPQ2d 1650 [sic, 1655, 1658 (Fed. Cir. 1990)]" (page 5 of Answer). However, since both references disclose

polymerization processes wherein one of the claimed reactants is not used, there is no factual basis for concluding that the reference processes inherently produce particles having the claimed particle size distribution. Also, Georges discloses the production of particles with a preferable medium diameter of from about 6 to about 12 Fm (column 11, line 55), whereas Wada obtains polymer particles in the range of from 1 to 30 Fm (column 2, line 18). Hence, it can be seen that both references disclose polymer particles having a size distribution outside the claimed range. Furthermore, another fact undermining the examiner's conclusion of inherency is that the process of Wada requires the use of a hardly soluble dispersant, such as tricalcium phosphate, whereas appellants' specification teaches no such use of a hardly soluble dispersant in the polymerization process.

Accordingly, we are constrained to conclude that the applied prior art fails to establish a prima facie case of obviousness for the claimed invention.

In conclusion, based on the foregoing, the examiner's decision rejecting the appealed claims is reversed.

REVERSED

EDWARD C. KIMLIN Administrative Patent Judge	)
JOHN D. SMITH Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
CHUNG K. PAK Administrative Patent Judge	)

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